

Appl. No. 10/639,685  
Reply to Office Action dated October 5, 2004  
Page 6

### **REMARKS/ARGUMENTS**

Claims 1-6 have been amended to more clearly define the present invention. The claims as amended provide for at least three of the torque transmitting mechanisms to include non-rotatable pistons in the respective servo mechanisms. While other patents may have a plurality of non-rotatable pistons, they are not disclosed nor suggested to be in the structures defined by the present invention.

The Claims 1-6 as originally presented were rejected under 35 U.S.C. § 103 as being obvious and therefore unpatentable in view of Martyka et. al in view of Fujikawa et. al and further in view of Shindo et. al. (Claims 1-4 and 6) and further in view of Frost (claim 5).

The Examiner admits that Martyka et. al. lacks any teaching of a three sectional housing and specific teaching of piston support regions. In an attempt to expand the disclosure of Martyka et. al., the Examiner suggests that the Fujikawa et. al. a teaching that can be combined to establish a three piece housing structure. A careful reading of Fujikawa et al. however, makes it clear that the teaching of that patent is directed to a structure to combine two planetary transmissions, namely an overdrive and direct drive transmission and a three speed transmission. At best, the combination of Martyka et. al. and Fujikawa et. al., would suggest the addition of an overdrive transmission to a seven speed transmission. There is no teaching in either of these patents to suggest the combination made by the Examiner. Perhaps the Examiner is suggesting that Martyka et. al. should provide a separate assembly for the torque-transmitting mechanisms 34, 38, 40, and 42, or perhaps the torque transmitting mechanisms and the planetary gearset 22 should be housed in a separate structure. Either of these combinations would be more in keeping with the teachings found therein.

In applying Martyka et. al. in view of Fujikawa et. al., the examiner puts forth that Shindo et. al. teaches a "similar transmission" with pistons supported in end walls as shown in FIG. 2 of that patent. Shindo et. al. is not a similar transmission. Martyka et. al. and Fujikawa et. al. are both multiple speed planetary transmissions while Shindo et. al. is a continuously variable transmission having a planetary gearset for forward and reverse operation. Also in FIG. 2, Shindo et. al. depicts the structure of FIG. 1 in Schematic representation. As noted in both FIGs. 1 and 2, the starting clutch 40 is mounted on a

Appl. No. 10/639,685

Reply to Office Action dated October 5, 2004

Page 7

countershaft and not on an end wall. The same can be said for the torque transmitting mechanisms 34 and 38 of Martyka et. al. Also the transmission of Shindo et. al. has a countershaft arrangement, this is necessary in CVTs. The combination of these teachings suggests that a countershaft be employed to support a starting clutch that is not needed on planetary transmission. There is no suggestion directing one to combine these patent teachings.

The Examiner suggests that Martyka et. al., with regard to Claim 3, has the servomechanisms of 34 and 36 and the servomechanisms of 40 and 42 substantially coaxially aligned (as defined by the present invention). The definition of substantially coaxially aligned or radially aligned is clearly shown in the drawings. Coaxially alignment places the structures along the same axis at substantially the same circumferential package (for example see 84 and 82C in FIG. 4), radial alignment places the structures on the same axis in substantially radially extending envelope (for example see 84A and 82A in FIG 2 or 80B and 140B in FIG 3). The torque transmitting mechanisms 34, 38, 40, and 42, of Martyka et. al., do not present any structure for the servomechanisms.

The Examiner then suggest with regard to Claim 4 that the pistons of servo mechanisms of torque transmitting mechanisms 34 and 40 are coaxially aligned. Accordingly, the pistons of the servomechanisms of the torque transmitting mechanisms 34, 40 and 36 must be coaxially aligned. There is no structure displayed in Martyka to support this contention. While the torque transmitting mechanisms of Martyka et. al. may have a common axis of rotation, they are not aligned.

The Examiner further suggests, in rejecting Claim 5, that the disclosure of Frost be added to the mix in order to point out the irrelevant that Frost has two brakes with pistons 154 and 174 supported on a bulkhead 60B. The piston 154 is also disposed on the housing 60 while the piston 174 is disposed within the piston 154. How this structure is to be combined with the structure of Fujikawa et. al. and Shindo et. al. is not evident nor explained. There is no teaching found to suggest that any of the cited art should be considered by Martyka et. al. From the piecemeal assembly of the prior art, it appears that the Examiner, with the present disclosure as a guide, went on a shopping spree. This is made evident by the cascading of references used by the Examiner in support of the rejections. The teaching of the combination of elements claimed by the present invention

Appl. No. 10/639,685  
Reply to Office Action dated October 5, 2004  
Page 8

is not found anywhere but in the instant disclosure. That these individual elements can be found piecemeal in various prior art teachings and then combined can only be done through hindsight. It is a simple matter for the Examiner to explore the present teaching and then, with this information in hand, scour the prior art to find the individual elements. A holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be "contrary to statute and would defeat the congressional purpose in enacting Title 35.

For example, see *In re Geiger* Unpublished decision (12/11/86)

*"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." Judge Archer.....Judge Newman found that the applicant had shown, by evidence, that his system had superior properties not rendered obvious by the cited references.*

The requirements necessary to support a conclusion that a claim is directed to "obvious" subject matter is found in *Ex parte Clapp*, 227 USPQ 972 (TTAB 1985).

*[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Laskowski, 10 USPQ2d 1397, 1398 (Fed Cir. 1989), citing In re Gordon, 221 USPQ 1125, 1127 (Fed Cir. 1984).*

With further reference to *Ex parte Clapp*, *Supra*, at 973:

*To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. ...It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.*

And, as stated in *Cornell v. Sears, Roebuck and Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983):

R

Appl. No. 10/639,685  
Reply to Office Action dated October 5, 2004  
Page 9

*The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.*

A precise statement as to the impropriety of a rejection, under 35 U.S.C. § 103 is found in the opinion of the CCPA rendered in the decision of *In re Linnert*, 309 F.2d 498, 503; 135 USPQ 307, 311 (1962):

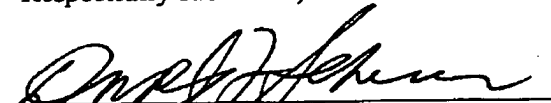
*Viewed in the light of the appellants' specification, the solution to the problem ... may seem obvious over the combined teachings of the references. Such a hindsight analysis, however, is not allowed by 35 U.S.C. § 103 which requires a comparison of the prior art and the invention as a whole at the time the invention was made.*

The CCPA went on to state:

*It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C § 103 is very specific in requiring that a rejection on the grounds the invention "would have been obvious" must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.*

In view of the above amendments and remarks, this application is believed to be in condition for allowance, which is herewith respectfully requested.

Respectfully submitted,



Donald F. Scherer, Attorney

Reg. No. 24,539

810-953-9268

9